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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,048	11/13/2003	Isabelle Rollat-Corvol	5725.0425-01	9222

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EXAMINER	
SOROUSH, LAYLA	
ART UNIT	**PAPER NUMBER**
1617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,048	ROLLAT-CORVOL ET AL.	
	Examiner	Art Unit	
	Layla Soroush	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2004*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1 and 3-44* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Office Action is in response to the Preliminary Amendment filed April 15, 2004. Claims 1, and 3-44 are pending and are subject to the restriction requirements set forth herein.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 3-40, drawn to a cosmetic composition comprising one branched polyester, and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants, classified in class 424, subclass 401.

II. Claims 41-43, drawn to a process for treating keratin fibers comprising applying cosmetic composition to the fibers, either before or after shaping the hairstyle, classified in class 424, subclass 401.

III. Claim 44, drawn to a method of making a cosmetic styling formulation, classified in class 424, subclass 401.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case Invention I is drawn to a cosmetic composition comprising one branched polyester, and at least one conditioning

agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas Invention II is drawn to a process for treating keratin fibers comprising applying cosmetic composition to the fibers. The composition of Invention I can be used as "a particle type powdery composite which can be easily dispersed in water, can be used as a wash agent, a bath agent, or a bleaching agent (JP 53130286A).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. The searches in non-patent literature databases are extensive and do not overlap thus presenting a search burden to be searched together. In searching Group I, Examiner will be focusing on the patentability of composition, and not the process for treating keratin fibers of Group II. Conversely, in searching Group II, Examiner will be focusing on the patentability of the process for treating keratin fibers and not the composition itself. Thus, Groups I and II have been appropriately restricted on the basis of being independent or distinct and presenting a search burden on the Examiner if they were to be searched together.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case In the instant case Invention I is drawn to a cosmetic composition comprising one branched polyester, and at least one conditioning

agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas Invention III is drawn to a method of making a cosmetic styling formulation. The composition of Invention I can be used as "a particle type powdery composite which can be easily dispersed in water, can be used as a wash agent, a bath agent, or a bleaching agent (JP 53130286A).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper. The searches in non-patent literature databases are extensive and do not overlap thus presenting a search burden to be searched together. In searching Group I, Examiner will be focusing on the patentability of composition, and not the method of making a cosmetic styling formulation of Group III. Conversely, in searching Group III, Examiner will be focusing on the patentability of the method of making a cosmetic styling formulation and not the composition itself. Thus, Groups I and III have been appropriately restricted on the basis of being independent or distinct and presenting a search burden on the Examiner if they were to be searched together.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, Invention II is drawn to a process for treating keratin fibers comprising applying cosmetic composition to the fibers whereas Invention III is drawn to a method of making a cosmetic styling formulation. A process for treating keratin fibers comprising applying

cosmetic composition to the fibers is different from a method of making a cosmetic styling formulation.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper. The searches in non-patent literature databases are extensive and do not overlap thus presenting a search burden to be searched together. In searching Group II, Examiner will be focusing on the patentability of the process for treating keratin fibers comprising applying cosmetic composition to the fibers, and not the method of making a cosmetic styling formulation of Group III: Conversely, in searching Group III, Examiner will be focusing on the patentability of the method of making a cosmetic styling formulation and not the process for treating keratin fibers comprising applying cosmetic composition to the fibers. Thus, Groups I and III have been appropriately restricted on the basis of being independent or distinct and presenting a search burden on the Examiner if they were to be searched together.

This application contains claims directed to the following patentably distinct species: inclusive of various sulphonic polyesters, non volatile silicones, cationic & amphoteric polymers, cationic & amphiphilic surfactants, and propellants.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, either a name or specific structure, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, and 3-44 are generic to a pluarality of sulphonic polyesters, non volatile silicones,

cationic & amphoteric polymers, cationic & amphiphilic surfactants, and propellants, the search for all of which presents an undue burden on the Office.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the

requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Election

A telephone call to the attorney is not required where: 1) the restriction requirement is complex, 2) the application is being prosecuted pro se, or 3) the examiner knows from past experience that a telephone election will not be made (MPEP 812.01). Since the restriction election is considered complex, a call to the attorney for a telephone election was not made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Sreenivasan Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER